

REMARKS/ARGUMENTS

Claims 1-13 are pending in the present application. The drawings have been objected to because there is no descriptive legend provided for each of the structural elements shown in Fig. 1. Claims 1-13 have been rejected under 35 U.S.C. 112, second paragraph as being indefinite. The Examiner has advised Applicant to point out the inventor and invention dates of each claim that is not commonly owned by the joint inventors. Claims 1-6 and 8-9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Joao in view of Scholl, et al. Finally, claims 7 and 10-13 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Joao and Scholl, et al. and further in view of Whitaker, et al. In response, Applicant has amended the claims, added new claims 15-20, and respectfully traverses the Examiner's rejections.

The Examiner has objected to the drawings because "there is no descriptive legend provided for each of the structural elements shown in Fig. 1." The applicant has revised the drawings to add a descriptive legend and therefore the applicant requests this objection be withdrawn.

Claims 1-13 were rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention. Specifically, the Examiner has rejected claims 1-4 because it was unclear what was meant by "default information". Consequently, the Applicant has amended claims 1, 2, 3 and 4 to change default to fault. The Examiner also believed that the phrase

"control information server" in claim 1 should be "central information server" in order to establish antecedent basis for claim 4. This amendment as suggested has been made. The Examiner also opined that claims 2-4 did not have an antecedent basis for the phrase "the fleet manager" and therefore claim 14 has been added to provide the needed antecedent basis. As per claim 5, the Examiner has considered it contextually unclear as to "what structural means perform the steps "sensing", "submitting" and "communication". Claim 5 has been amended to address this concern. Claim 7 was rejected because the Examiner believes that the terms "a crop processing fault" and "a pre defined threshold" should be rewritten as "said crop processing fault" and "said predefined threshold". Consequently, the Applicant amended claim 7 as requested. The Examiner rejected claim 11 stating "the recitation therein is also contextually unclear. Further, the limitation on lines 1 and 2 have already been recited and in the parent claim 5 and therefore should be deleted. Moreover, it is unclear as to what structural means performs the steps of "sensing" and "transmitting". Finally, the phrase "the same" is considered vague and indefinite." Claim 11 has been amended to address all of these concerns. Hence, claims 1-5, 7 and 11 have all been amended as requested by the Examiner and claim 14 has been added to provide antecedent basis to all of the claims and to make all of the claims definite. Therefore, claims 1-14 are considered in allowable form.

The Examiner has requested that the Applicant point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in

order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential of 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a). In response, Applicant affirms the Examiner's presumption that the subject of the various claims was commonly owned at the time any inventions covered therein were made.

The Examiner has rejected claims 1-6 and 8-9 under 35 U.S.C. 103(a) as being unpatentable over Joao in view of Scholl et al and claims 7, 10-13 as being unpatentable over Joao and Scholl et al in further view of Whitaker. All of the claims depend on claim 1. The Applicant respectfully disagrees and asserts that the Examiner has not established a prima facie case of obviousness.

There is No Suggestion or Motivation to Combine the Prior Art to Make Out a Prima Facie Case of Obviousness

An obviousness analysis begins in the text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field. See,

e.g. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.

See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.")

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the

pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

The Examiner's obvious rejections of claims 1-6 and 8-9 are based on a combination of prior art references, e.g., the method for monitoring equipment for a machine fault and transmitting that fault to a central server and then transmitting the information to an owner as taught in Joao, combined with the device of Scholl wherein the fault information is diagnosed at the machine. To justify this combination the Examiner simply states "it would have been obvious for a person having ordinary skill in the art to incorporate such well known feature as taught in Scholl, et al. into the Joao system so that the processing load and central processing server can be reduced." (Examiner's Answer, page 4). Rather than pointing to specific information in Joao or Scholl that suggests the combination of the monitoring systems, the Examiner described the general functions of how the method of monitoring is achieved and how fault information is diagnosed. Nowhere does the Examiner particularly identify any suggestion, teaching, or motivation to combine the prior art references such as the identification of the relevant art, the level of

ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis. See e.g., Pro-mold and Tool, 75 F.3d at 1573 (37 USPQ 2d at 1630).

To the contrary, the Examiner's conclusion is based on a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention. (Examiner's Answer, page 4). Yet this reference by reference, limitation by limitation analysis fails to demonstrate how the Joao and Scholl references teach or suggest their combination to yield the claimed invention. For example, the Examiner has not explained why, if it was obvious to make the proposed combination, that the monitoring system in Joao (2002) did not combine the element of the fault information being diagnosed at the machine as disclosed in Scholl (1995) when this option was readily available at the time of invention. In contrast, Joao as a person of ordinary skill in the art, chose to diagnose the fault information at the central information server instead of at the machine as required by independent claim 1 of Applicant's application. (Joao, paragraph 0177.) In this respect Joao teaches away from the proposed combination. This is a point the Examiner did not address in the office action.

A factor cutting against the finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led

in a direction divergent from the path the appellant took. In re Gurley, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). Here, because Joao teaches the use of fault information that is diagnosed at the central information server, one skilled in the art upon reading Joao would have been led in a path divergent from that taken by the applicants.

In addition, in rejecting claim 7 and 10-13, the Examiner has further combined Joao and Scholl with Whitaker. Specifically, the Examiner justified the combination by stating first that "the Joao reference on page 9 discloses that the diagnosed fault information [operational] can be associated with any machines or vehicles." (page 5). After recognizing that Whitaker teaches "crop processing" fault information, the Examiner stated that "[h]ence, it would have been readily apparent for one skilled in the art, based on the direct suggestion found in Joao, to incorporate such well known fault information associated with a combine as taught in Whitaker et al. into the Joao system in the event that the machine used in Joao system is a combine as claimed." While Joao suggests its use with any type of machine, it only suggests the diagnosis of operational fault information for any type of machine and not crop processing fault information. Nowhere, does the Examiner point to any suggestion in either Joao, or Scholl or Whitaker where it is desirable to substitute the diagnosis of crop processing fault information as shown in Whitaker, with the operational fault information data of Joao.

Accordingly, because the Examiner has not particularly identified any suggestion, teaching, or motivation to

combine the prior art references, in addition to the disclosure of Joao which teaches away from the proposed combination, the Examiner's conclusion of obviousness, as a matter of law, cannot stand.

CONCLUSION

In view of the above amendments and remarks, Applicant believes claims 1-14 and new claims 15-20 are in condition for allowance and respectfully requests allowance of such claims. If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 50-2098.

Respectfully submitted,



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